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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/594,777

10/04/2007

Matthew Trevor Snowden

Stolt-57

7103

39703

7590

04/12/2011

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EXAMINER

ANDRISH, SEAN D

ART UNIT

PAPER NUMBER

3672

MAIL DATE

DELIVERY MODE

04/12/2011

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/594,777

Applicant(s)

SNOWDON ET AL.

Examiner

Sean Andrish

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2011.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 - 13 and 15 - 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 - 13 and 15 - 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**sDETAILED ACTION**

**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 7 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claims 7 and 10 recite the tensioner is detached from the tiltable structure when the apparatus is in the second mode, but the drawings illustrate tensioner 204 is attached to the tiltable structure 202 when the apparatus is in the second mode (Fig. 3).

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1 - 13 and 15 - 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. The use of the words "it" and "its", as recited in claims 1 and 15, renders the claims indefinite as it is unclear as to which structural element or limitation the term is referring. Structural elements or limitations should always be referred to by name.

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- b. Regarding claims 3, 5, 8, 16, and 17, the term "can" renders the claim indefinite as "can" implies that the respective limitation is not required. Therefore, it is not possible for the examiner to determine the metes and bounds of the claim.
- c. Regarding claim 10, it is unclear which elements are "being detachable" when the apparatus is in the second mode.

### **Claim Rejections - 35 USC § 103**

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

- 1. Determining the scope and contents of the prior art.
- 2. Ascertaining the differences between the prior art and the claims at issue.
- 3. Resolving the level of ordinary skill in the pertinent art.
- 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1 - 13, and 15 - 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Recalde (4,721,411).

Regarding claims 1, 6, 21, and 22, Recalde discloses an apparatus comprising: a tensioner (1384); a structure that is tiltable between upright and substantially horizontal states; the apparatus is operable in a first mode, wherein the longitudinal axis of tiltable structure is at an elevated angle and a second mode, wherein the longitudinal axis of the tiltable structure is

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substantially horizontal; and a support structure (roller ramp 1336) for diverting the flexible elongate product (pipeline 1326) to the desired curvature (Figs. 41, 45, and 46; column 35, lines 17 – 35; column 36, lines 53 - 58). Although Recalde does not explicitly state that the “desired curvature” diverts the flexible product to a more vertical angle, it would have been an obvious design consideration within the skill in the art.

Regarding claim 2, Recalde further discloses a radius controller and a straightener (1386) (Figs. 41, 45, and 46; column 36, line 19).

Regarding claims 3 and 17, Recalde further discloses a removable module (1302) (Fig. 45).

Regarding claims 4 and 5, Recalde further discloses the support structure comprises a sheave (rollers 1338, 1340, 1342, 1344) (Figs. 45 - 47; column 35, lines 31 - 32).

Regarding claims 7 and 20, as discussed above the tensioner of the present application is attached to the tiltable structure when in the second mode (Fig. 3). Since the tensioner as taught by Recalde is identical to the tensioner of the present application, Recalde teaches the tensioner is detached from the tiltable structure while in the second mode inasmuch as the tensioner of claimed invention is detached from the tiltable structure.

Regarding claim 8, Recalde discloses all of the claim limitation(s) except for the tiltable structure can be operated in the second mode at a range of angles either side of vertical. It would have been considered obvious to one of ordinary skill in the art, at the time the invention was made, to have modified the apparatus as disclosed by Recalde such that the tiltable structure can be operated in the second mode at a range of angles either side of vertical to increase the available work space on the deck of the vessel.

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Regarding claims 9 and 18, Recalde further discloses the tensioner (1384) in the second mode is located at a position displaced horizontally from a location from which it will be elevated by said tiltable structure in the first mode (Figs. 41, 45, and 46).

Regarding claim 10, Recalde further discloses a pair of legs pivoted to the deck of the vessel at their lower ends and joined by a crossbeam at their upper ends, the tensioner (118) in the first mode being carried between the legs below the crossbeam (roller track 1144), with a straightener (114) and radius controller (1160) mounted above the crossbeam and being detachable when adapting the apparatus into the second mode (Fig. 41). Examiner has interpreted the claim as requiring the tensioner to be detachable when adapting the apparatus into the second mode. Examiner notes that the crossbeam (1144) is located adjacent tensioner/straightener (116) and since tensioner (118) is located below tensioner/straightener (116), tensioner (118) is carried below the crossbeam (see Fig. 41 below). Examiner explains that since the tensioner (118) can be removed from the tiltable apparatus at any time, it is capable of being detachable when adapting the apparatus into the second mode.



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ordinary skill in the art to detach the sheave (1336) to simplify the apparatus for laying elongate articles by reducing the number of system components and decreasing maintenance costs.

### **Response to Arguments**

8. Applicant's arguments with respect to claims 1 - 13 and 15 - 22 have been considered but are moot in view of the new ground(s) of rejection.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sean Andrish whose telephone number is (571)270-3098. The examiner can normally be reached on Mon - Fri, 7:30am - 5:00pm, Alternate Fri off, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on (571) 272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sunil Singh/  
Primary Examiner, Art Unit 3672

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Primary Examiner  
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SDA  
4/7/2011